

REMARKS/ARGUMENTS

The Office Action mailed December 24, 2002 has been carefully reviewed. Reconsideration of this application as amended and in view of the following remarks is respectfully requested.

Restriction Requirement

In the Office Action mailed December 24, 2002 the Examiner noted that Applicants have elected group II, claims 13-25. The non-elected claims are group I, claims 1-12 and group III, claims 26-34. By this Amendment Applicants have canceled claims 1-12 and 26-34 subject to Applicants right to file a divisional application containing claims covering the inventions defined by claims 1-12 and 26-34.

35 USC 102 Rejection

In the Office Action mailed December 24, 2002, the Examiner rejected claims 13, 21 and 23-25 under 35 USC 102(b) "as being anticipated by WO 89/01842."

The Examiner stated that original claims 13, 21 and 23-25 are "anticipated by WO 89/01842." Applicants point out that the steps of amended claim 13 and the dependent claims 21 and 23-25 are not shown by WO 89/01842. For example, the following steps of amended claim 13 are not shown by WO 89/01842:

generating a first high power percussive laser beam,

said high power percussive laser beam being focused to a diameter slightly smaller than said diameter of said hole,

directing said first high power percussive laser beam at said material to remove the bulk of said material to form a ragged hole having a diameter slightly smaller than said diameter of said hole,

generating a second trepanning laser beam,

said second trepanning laser beam having a spot diameter substantially smaller than said diameter of said hole, and

directing and trepanning said second trepanning laser beam at said hole being formed for accurately cleaning up said ragged hole so that said final hole has said diameter and has dimensions of high precision

The 35 USC 102(b) rejection is unsupported by the art. As stated in Verdegaal Bros. v. Union Oil Co of California, 814 F.2nd 628, 631 USPQ 1051, 1053 (Fed. Cir. 1987), "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. Since the steps of amended claim 13 and dependent claims 21 and 23-25 are not shown by WO 89/01842, the rejection is unsupported by the art.

35 USC 103 Rejection

In the Office Action mailed December 24, 2002, the Examiner rejected claims 14-20 and 22 under 35 USC 103(a) "as being unpatentable over WO 89/01842 in view of Inagawa et al (US 5,166,483)."

Applicants respectfully traverse the rejection of dependent claims 14-20 and 22 under 35 U.S.C. §103(b). The cited references do show the claimed combination. There is no suggestion in the references to form a proper combination. The cited references do not provide a teaching of the claimed combination.

As stated above in connection with Applicants response to the 35 USC 102 rejection, many of the steps of amended claim 13 are not shown by the primary reference WO 89/01842. The missing steps are enumerated above.

The secondary reference, US 5,166,483 Inagawa et al, also fails to show many of the steps of amended claim 13. For example, the following steps of amended claim 13 are not shown by the secondary reference, US 5,166,483 Inagawa et al:

generating a first high power percussive laser beam, said high power percussive laser beam being focused to a diameter slightly smaller than said diameter of said hole,

directing said first high power percussive laser beam at said material to remove the bulk of said material to form a ragged hole having a diameter slightly smaller than said diameter of said hole,

generating a second trepanning laser beam,

said second trepanning laser beam having a spot diameter substantially smaller than said diameter of said hole, and

directing and trepanning said second trepanning laser beam at said hole being formed for accurately cleaning up said ragged hole so that said final hole has said diameter and has dimensions of high precision

The rejected claims 14-20 and 22 are dependent claims depending from amended claim 13. The missing steps described above are not shown by either the primary reference, WO 89/01842, or the secondary reference, US 5,166,483 Inagawa et al.

Since neither the primary reference nor the secondary reference show the missing steps, a combination of the primary and secondary reference also does not show the missing steps or the claimed invention. Applicants respectfully

submit that the cited references do show the claimed combination, there is no suggestion in the references to form a proper combination, nor do the cited references provide a teaching of the claimed combination.



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Application No.: 09/781,073

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated December 24, 2002 have been fully addressed and overcome. The present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,

Eddie E. Scott
Attorney for Applicant
Registration No. 25,220
Tel. No. (925) 424-6897

Livermore, California

Dated: February 13, 2003

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